

REMARKS

Claim Amendments

In an effort to focus Applicants' claim and move the case forward, Applicants have amended independent claim 1 to include the limitation in dependent claims 3 and 6. Applicants have amended independent claim 12 to include the limitation in dependent claims 13-15. Applicants have also amended independent claim 17 to include the limitation in dependent claims 19 and 22. Applicants have cancelled claims 3, 6, 13-15, 19, and 22. To correct dependency relationships, Applicants have amended claims 4, 5, 16, 20, and 21.

Claim Rejections – 35 U.S.C. § 101

Claims 12-16 stand rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter. On August 15, 2007, Applicants and Examiner Dulaney discussed amendments to claims 12 and 16 in an effort to overcome the rejections under 35 U.S.C. § 101. In an effort to move the case forward, Applicants have amended claims 12 and 16. As mentioned above, Applicant note that claims 13-15 are cancelled.

Claim Rejections – 35 U.S.C. § 102 Over Takimoto

Claims 1, 5, 7-8, 10, 12, 17, 21, and 24 stand rejected under 35 U.S.C § 102(b) as being anticipated by Takimoto (U.S. Patent No. 6,202,092). To anticipate claims 1, 5, 7-8, 10, 12, 17, 21, and 24 under 35 U.S.C. § 102(b), two basic requirements must be met. The first requirement of anticipation is that Takimoto must disclose each and every element and limitation as set forth in the Applicant's claims. The second requirement of anticipation is that Takimoto must enable Applicant's claims. Takimoto does not meet either requirement and therefore does not anticipate Applicant's claims.

**Takimoto Does Not Disclose Each and Every Element
Of The Claims Of The Present Application**

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As amended, independent claim 1 of the present application recites:

1. A data processing network, comprising:

a first printer connected to a network medium;

a set of print clients connected to the network medium, wherein each print client is enabled to permit a user to submit a print job to the first printer;

a first print job table to store information indicative of first printer capacity available to the user, the first print job table being stored in a computer readable medium; and

computer code means for:

determining whether to accept a new print job submitted by the user based on a comparison of the size of the new print job and the user's available first printer capacity, and

updating the available capacity information, including deleting a first print job table entry corresponding to the user responsive to determining that the user's available first printer capacity is equal to or greater than a predetermined threshold.

As explained in more detail below, Takimoto does not disclose each and every element of claim 1, and Takimoto therefore cannot be said to anticipate the claims of the present application within the meaning of 35 USC § 102(b).

Takimoto Does Not Disclose Updating the Available Capacity Information, Including Deleting a First Print Job Table Entry Corresponding to the User Responsive to Determining That the User's Available First Printer Capacity is Equal to or Greater than a Predetermined Threshold

The Office Action takes the position that Takimoto at column 5, lines 16-19, and column 5, lines 30-35, discloses: updating the available capacity information, including deleting a first print job table entry corresponding to the user responsive to determining that the user's available first printer capacity is equal to or greater than a predetermined threshold. Applicants respectfully note in response, however, that what Takimoto at column 5, lines 16-19, and column 5, lines 30-35, in fact discloses is:

If the print request fails to satisfy one or more of the requirements, the security validating portion 22b does not authorize the requested print job, and an error indication is given (step S12 in FIG. 2).

...

When the printer 3 prints, the statistical information managing portion 22d adds the number of printed pages with regard to each kind of paper or paper feeder and the number of times a special printing function is used to the cumulative total for these values, and updates the security data base with the result of the addition (step S11 in FIG. 2).

That is, Takimoto at column 5, lines 16-19, discloses not authorizing a user's requested print job if the print request fails to satisfy certain requirements. Takimoto at column 5, lines 30-35, discloses updating a security database with the number of printed pages with regard to each kind of paper or paper feeder and the number of times a special printing function is used when the printer prints. Takimoto's disclosure of not authorizing a user's requested print job and updating a security database with the number of printed pages with regard to each kind of paper or paper feeder and the number of times a special printing function is used, however, does not disclose updating the available capacity

information, including deleting a first print job table entry corresponding to the user responsive to determining that the user's available first printer capacity is equal to or greater than a predetermined threshold. Takimoto at column 5, lines 16-19 and 30-35, does not disclose deleting any entry from any print job table. In addition, the cited sections of Takimoto does not disclose doing anything in response to determining that the user's available first printer capacity is equal to or greater than a predetermined threshold. In fact, the cited sections of Takimoto never even discuss comparing a user's available print capacity to a predetermined threshold. Takimoto instead merely discloses determining whether the print request fails to satisfy certain requirements and updating fields in a security database if a printer prints. Because Takimoto does not disclose each and every element and limitation of Applicants' claims, Takimoto does not anticipate Applicants' claims, and the rejections under 35 USC § 102(b) should be withdrawn.

Takimoto Does Not Enable Each and Every Element Of The Claims Of The Present Application

Not only must Takimoto disclose each and every element of the claims of the present application within the meaning of *Verdegaal* in order to anticipate Applicants' claims, but also Takimoto must be an enabling disclosure of each and every element of the claims of the present application within the meaning of *In re Hoeksema*. In *Hoeksema*, the claims were rejected because an earlier patent disclosed a structural similarity to the Appellant's chemical compound. The court in *Hoeksema* stated: "We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). The meaning of *Hoeksema* for the present case is that unless Takimoto places Applicants' claims in the possession of a person of ordinary skill in the art, Takimoto is legally insufficient to anticipate Applicants' claims under 35 U.S.C. § 102(e). As explained above, Takimoto does not disclose each and every element and limitation of independent claim 1 of the present application. Because Takimoto does not disclose each and every element and limitation

of the independent claims, Takimoto cannot possibly place the elements and limitations of independent claim 1 in the possession of a person of ordinary skill in the art. Takimoto cannot, therefore, anticipate claim 1 of the present application.

Relations Among Claims

Independent claims 12 and 17 claim computer product and apparatus aspects of the method claimed in independent method claim 1. For the same reason that Takimoto does not disclose or enable independent claim 1, Takimoto does not disclose or enable independent claims 12 and 17. Independent claims 12 and 17 are therefore patentable and should be allowed.

Claims 5, 7-8, 10, 21, and 24 depend respectively from independent claims 1, 12, and 17. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because Takimoto does not disclose or enable each and every element of the independent claims, Takimoto does not disclose or enable each and every element of the dependent claims of the present application. As such, claims 5, 7-8, 10, 21, and 24 are also patentable and should be allowed.

Claim Rejections – 35 U.S.C. § 103(a)

Claims 2, 4, 9, 16, 18, and 20 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Takimoto in view of either Bauer, *et al.* (U.S. Patent No. 5,819,047), Salgado (U.S. Patent No. 5,777,882), Official Notice, or both Iwata, *et al.* (U.S. Patent No. 7,167,260) and Sommer, *et al.* (U.S. Patent No. 7,158,244). The question of whether Applicants' claims are obvious *vel non* is examined in light of: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) any relevant secondary considerations, including commercial success, long felt but unsolved needs, and failure of other. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1729-1730 (2007). Although Applicants recognize that such an inquiry is an expansive and flexible one, the Office

Action must nevertheless demonstrate a prima facie case of obviousness to reject Applicants' claims under for obviousness under 35 U.S.C. § 103(a). *In re Khan*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

To establish a prima facie case of obviousness, the proposed combination of the references must teach or suggest all of the claim limitations of dependent claims 2, 4, 9, 16, 18, and 20. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Dependent claims 2, 4, and 9 depend from independent claim 1 and include all the limitations of the independent claim from which they depend. Dependent claim 16 depends from independent claim 12 and includes all the limitations of the independent claim from which it depends. Dependent claims 18 and 20 depend from independent claim 17 and include all the limitations of the independent claim from which they depend. In rejecting dependent claims 2, 4, 9, 16, 18, and 20, the Office Action relies on Takimoto as disclosing each and every element of independent claims 1, 12, and 17. As shown above, Takimoto in fact does not disclose each and every element of independent claims 1, 12, and 17. Because Takimoto does not disclose each and every element of independent claims 1, 12, and 17, the proposed combinations of references with Takimoto cannot possibly disclose each and every element of dependent claims 2, 4, 9, 16, 18, and 20. The proposed combinations of references with Takimoto, therefore, cannot establish a prima facie case of obviousness, and the rejections of claims 2, 4, 9, 16, 18, and 20 under U.S.C. § 103(a) should be withdrawn.

In addition to the fact that the Office Action has not established a prima facie of obviousness there is at least another reason that the rejections of claims 2, 4, 9, 16, 18, and 20 should be withdrawn: The Office Action does not examine Applicants' claims in light of the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). As mentioned above, the question of whether Applicants' claims are obvious *vel non* is examined in light of: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) any relevant secondary considerations, including commercial success, long felt but unsolved needs, and failure of others. *KSR Int'l Co. v. Teleflex Inc.*, No. 04-

1350, slip op. at 2 (U.S. April 30, 2007); *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). “To facilitate review, this analysis should be made explicit.” *KSR*, slip op. at 14 (citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)). That is, the Office Action must make explicit an analysis of the factual inquiries set forth in *Graham*. In present case, however, the Office Action does not even mention the factual inquiries set forth in *Graham*. As such, the rejections of claims 2, 4, 9, 16, 18, and 20 under 35 U.S.C. § 103 are improper and should be withdrawn.

Official Notice Is Not Available To The Examiner

The Office Action at page 8 invokes Official Notice with regard to claims 11 and 23. According to MPEP § 2144.03, the Examiner may make use of Official Notice of facts outside the record only if such facts are capable of instant and unquestionable demonstration as being well-known in the art. Official Notice, however, may not be substituted for facts which cannot be instantly and unquestionably demonstrated. Regarding claims 11 and 23, the Office Action at page 8 states:

Examiner takes official notice that storing user print data on a printer is obvious and well known to one of ordinary skill in the art. The motivation for doing this with Takimoto would be to eliminate the need for a separate server.

That is, the Office Action makes a mere naked assertion that storing user print data on a printer is obvious and well known to one of ordinary skill in the art. Whether storing user print data on a printer is obvious and well known to one of ordinary skill in the art, however, cannot be instantly and unquestionably demonstrated. In making such an assertion, the Office Action neglects to provide any evidence that even suggests that storing user print data on a printer is obvious and well known to one of ordinary skill in the art. As such, the Office Action’s invocation of Office Notice is improper and should be withdrawn.

Conclusion

Claims 12-16 stand rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter. In accordance with Applicant's discussion with Examiner Dulaney on August 15, 2007, Applicants have amended claims 12 and 16 in an effort to overcome the rejections under 35 U.S.C. § 101. Applicants again note that claims 13-15 are cancelled. Applicants submit that the claims 12 and 16 are in condition for allowance.

Claims 1, 5, 7-8, 10, 12, 17, 21, and 24 stand rejected under 35 U.S.C. § 102 as being anticipated by Takimoto. As explained above, Takimoto does not disclose each and every element of Applicants' claims and does not enable Applicants' claims. Takimoto therefore does not anticipate Applicants' claims, and claims 1, 5, 7-8, 10, 12, 17, 21, and 24 should be allowed. Applicants traverse each rejection individually and respectfully request reconsideration of claims 1, 5, 7-8, 10, 12, 17, 21, and 24.

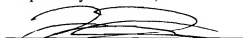
Claims 2, 4, 9, 16, 18, and 20 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Takimoto in view of either Bauer, *et al.* (U.S. Patent No. 5,819,047), Salgado (U.S. Patent No. 5,777,882), Official Notice, or both Iwata, *et al.* (U.S. Patent No. 7,167,260) and Sommer, *et al.* (U.S. Patent No. 7,158,244). As explained above, the proposed combinations of references with Takimoto does not teach or suggest each and every element of Applicants' claims. Claims 2, 4, 9, 16, 18, and 20 are therefore patentable and should be allowed. Applicants traverse each rejection individually and respectfully request reconsideration of claims 2, 4, 9, 16, 18, and 20.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 50-0563 for any fees required or overpaid.

Date: August 30, 2007

By:

Respectfully submitted,



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